

Preliminary Amendment  
Applicant: Spann  
Serial No.: 09/757,255  
Filed: January 9, 2001

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37. (New) A device according to claim 36 further comprising at least one leg attached to the hoops, thereby forming a stable structure.
38. (New) A device according to claim 37 wherein an outward extent of the at least one leg defines a footprint, wherein a vertical projection through a center of gravity of an elongate member inserted between the hoops lies within the footprint.
39. (New) A method for storing elongate members comprising the steps of:
  - providing a first rail and a second rail vertically and horizontally offset from each other thereby forming an opening therebetween for receiving an elongate member in a generally vertical orientation without providing means for supporting a lower end of the elongate member when received between the rails; and
  - inserting the elongate member between the rails.
40. (New) A method according to claim 39 wherein the rails comprise generally opposed edges for contacting the elongate member when inserted therebetween.
41. (New) A method according to claim 40 further characterized by at least one depression formed along the opposed edges in each of the rails.
42. (New) A method according to claim 41 wherein the depressions formed along the opposed edges in each of the rails are generally aligned, thereby restricting movement of the elongate member when disposed therein.

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#### REMARKS

The undersigned attorney thanks Examiner Novosad for her time and courtesy extended during a telephonic interview with the undersigned attorney and Christopher W. Stamos on September 26, 2002, and for the helpful suggestions with respect to claim amendments.

*Interview  
Record OK  
-D 12/7/02*

#### Status of the Claims

Prior to entry of this Amendment, claims 1-23 are pending in the application; however, claims 8-15 have been withdrawn for consideration as being drawn to unelected species. Claims

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1-5 and 16-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,004,673 to Emery ("Emery"). Claims 6, 7, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Emery in further view of U.S. Patent 2,032,631 to Pushee ("Pushee").

Applicant hereby further amends claims 1 and 16 and adds new claims 24-42. In accord with 37 C.F.R. § 1.121, attached is a clean copy of all pending claims and a copy of a marked-up version of the amended claims.

In view of the above amendments and following remarks, reconsideration and withdrawal of all grounds of objection and rejection are respectfully requested.

Amendments to the Claims

Applicant amends claims 1 and 16 per the Examiner's suggestion to replace "generally horizontally disposed means" with "substantially horizontally disposed means." No new matter has been introduced by this amendment. Support of these amendments can be found throughout the specification, for example, at page 9, lines 18-26; page 11, lines 12-27; and Figures 4 and 5.

Applicant also adds new claims 24-42 to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been introduced. Support of these claims can be found throughout the specification, for example, at page 6, line 19 through page 7, line 2; page 8, lines 19-25; and Figures 1 and 2, as well as in pending claims 1-23.

Rejection under 35 U.S.C. § 102(b)

Claims 1-5 and 16-22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Emery. Applicant respectfully traverses this rejection and submits that Emery does not anticipate Applicant's claims because Emery does not describe each element of independent claims 1 and 16, as amended, or claims 2-5, and 17-22 that depend therefrom.

Briefly, Emery discloses a display stand for fishing rods, the display stand including a base 2, an upright supporting member 3 with an upper supporting panel 5 mounted thereon, and a pair of base panels 7, 8 attached to the base 3 and sloping downwardly at a steep angle. See Emery, col. 2, lines 11-15, 25-33 and Figure 1. The base panels 7, 8 have retaining bars 30, 31 mounted thereon in outwardly spaced parallel relation thereto. See Emery, col. 3, lines 17-19.

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The retaining bar includes a plurality of rollers rotatably mounted thereon. See id. at lines 19-22. Each fishing rod is stored in a generally upright position secured between the upper supporting panel and a roller of the retaining bar with the butt end of the fishing rod resting on the outer face of the base panel. See, id. at lines 47-55.

In order for a claim to be anticipated under 35 U.S.C. §102(b), each and every limitation must be found in a single reference. Applicants respectfully submit that Emery fails to meet this exacting standard with respect to claims 1 and 16, as amended.

In particular, independent claims 1 and 16, as amended, require, *inter alia*, “substantially horizontally disposed means for supporting a lower end of the elongate member when received between the rails.” Thus, as set forth in the claims and the description, the surface of Applicant’s means for supporting a lower end of the elongate member is substantially horizontally disposed (i.e., having an orientation that is more horizontal than vertical).

Emery describes that “[t]he panels 7 and 8, the retaining bars 30 and 31, and the upper supporting panel 5, are so constituted and arranged relative to each other that fishing rods ... may be mounted ... with the butt ends... thereof resting on the outer faces of the panels 7 and 8...” In contrast to Applicant’s claims, however, Emery requires that “the retaining bar 30 or 31 is effective to wedge or clamp the fishing rod into abutting engagement with the outer face of the panel 7 or 8.” Emery, col. 3, lines 46-53 and 69-71. Specifically, to achieve such abutting engagement, Emery requires that “the panels 7 and 8 [are]... disposed at downwardly and outwardly sloping acute angles to the vertical.” Emery, col. 2, lines 30-34 and Figures 1, 3.

Thus, Emery essentially describes a stand having a leaning bar with an additional structure for securing the butt end of an elongate member. Emery, however, does not describe “substantially horizontally disposed means for supporting a lower end of the elongate member when received between the rails,” as claimed in independent claims 1 and 16, as amended, because Emery’s panels are not substantially horizontal. The panels of Emery are clearly more vertical than horizontal.

Moreover, Emery actually teaches one of ordinary skill in the art away from supporting lower ends of the elongate members by a substantially horizontally disposed means, because the principle of operation of Emery’s fishing rod stand requires his panels to be disposed at sloping

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acute angles to wedge the rods. Specifically, Emery relies on the acute angle wedge to provide both horizontal and vertical reaction forces to the butt end, both of which are required for Emery's stand to work. This is fundamentally different from Applicant's claimed invention, wherein the support provides only a vertical or stopping force for the lower end of the elongate member. The horizontal force is provided by the tool weight reacting against the rails. While some structure may be useful to stop, index, locate, or constrain the downward vertical movement of the tool when inserted, the function of this structure is distinct from the supporting function of the rails. According to Applicant's invention, primary support of the elongate member is accomplished by the rail design and offset configuration.

Accordingly, Applicant respectfully submits that, for at least the foregoing reasons, Emery fails to be a proper anticipatory reference and thus independent amended claims 1 and 16, and claims 2-7 and 17-23, that depend therefrom, are patentable. Reconsideration and withdrawal of the rejection of claims 1-5 and 16-22 under 35 U.S.C. §102(b) are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 6, 7, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Emery in further view of Pushee. Applicant respectfully traverses this rejection and submits that Emery and Pushee, either alone or in proper combination, do not render Applicant's claims unpatentable because these references do not describe every element of independent claim 1, as amended

As explained above, Emery does not teach or suggest "substantially horizontally disposed means for supporting a lower end of the elongate member when received between the rails," as recited in independent claim 1, as amended, because Emery's panels are not substantially horizontal.

Briefly, Pushee discloses a brush display rack having two walls, a front wall and a rear wall. See Pushee, col. 1, lines 1-2, and Figures 1-2. The front wall includes spaced-apart panels for receiving brush handles therebetween. See id. at lines 34-40. The rear wall serves as a support for brush heads. See id. at lines 28-29 and 43-44 and Figures 1-2. Brushes are displayed

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in stacks in spaces between panels. See id. at lines 37-39 and Figures 1-2. Thus, Pushee does not cure the deficiencies of Emery with respect to claim 1, because Pushee fails to teach or suggest any structure for supporting a lower end of the brush handle when received between the walls.

Accordingly, because claims 6, 7, and 23 depend directly or indirectly from independent claim 1 and include all of the limitations thereof, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6, 7, and 23 under 35 U.S.C. §103(a).

New Claims

Applicant respectfully submits that Emery, Pushee, and any other prior art of record, either or alone or in proper combinations, fail to describe or suggest every element of newly added independent claims 24 and 39, or claims 25-38 and 40-42 that depend respectively therefrom.

In particular, Emery does not describe or suggest a “tool holding device lacking means for supporting a lower end of the elongate member when received between the rails.” As explained above, Emery describes that “[t]he panels 7 and 8, the retaining bars 30 and 31, and the upper supporting panel 5, are so constituted and arranged relative to each other that fishing rods ... may be mounted ... with the butt ends... thereof resting on the outer faces of the panels 7 and 8.” Emery, col. 2, lines 30-34 and Figures 1, 3. Thus, Emery essentially describes a stand that, in contrast to the Applicant’s invention recited in claims 24-42, requires an additional structure for securing the butt end of an elongate member.

With respect to Pushee, Applicant respectfully points out that Pushee does not teach or suggest the rails “forming an opening therebetween for receiving an elongate member in a generally vertical orientation.” Specifically, in contrast to Applicant’s claims, Pushee does not teach or suggest that his brushes are received between the walls 11 and 15 in a generally vertical orientation, because Pushee discloses that brushes are supported in the space 15a-15d between panels of the front wall 15 and by the top edge of the rear wall. That is, Pushee’s brushes lie on top of the contours of the walls 15 and 11, not between the walls.

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## CONCLUSION

Applicant requests that the Examiner reconsider the application and claims in light of the foregoing Preliminary Amendment, and respectfully submits that all of claims 1-42 are in condition for allowance. If, in the Examiner's opinion, a telephonic interview would clarify issues and expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

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### **MARKED-UP VERSION OF AMENDED CLAIMS**

1. (Twice Amended) A tool holding device comprising:
  - a first rail and a second rail vertically and horizontally offset from each other thereby forming an opening therebetween for receiving an elongate member in a generally vertical orientation; and substantially[generally] horizontally disposed means for supporting a lower end of the elongate member when received between the rails.
16. (Twice Amended) A method for storing elongate members comprising the steps of:
  - providing a first rail and a second rail vertically and horizontally offset from each other thereby forming an opening therebetween for receiving an elongate member in a generally vertical orientation;
  - providing substantially[generally] horizontally disposed means for supporting a lower end of the elongate member when received between the rails; and
  - inserting the elongate member between the rails.